

Remarks

Claims 1, 23-25, 27 and 28 have been rejected. By this supplemental response, claims 1, 23, 24 and 27 have been amended and new claims 29-31 have been added. Support for the claim amendments can be found in the specification, and as such, add no new matter.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Office has rejected claims 1, 23-25, 27 and 28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and has stated that “The amended claims are drawn to methods comprising using any type of tissue sample and methods using almost any probe or primer” (see page 3 of the 5/24/2006 Advisory Action). However, the Office has stipulated that claims 1, 23-25, 27 and 28 are “free of the prior art teaching a method for detecting the presence of at least one of squamous cell carcinoma and prostate cancer comprising detecting SEQ ID NO:1 or SEQ ID NO:3” (see page 4 of the 5/24/2006 Advisory Action).

Claims 1, 23, 24 and 27 have been amended as per the suggestion of the Office (see pages 3-4 of the 5/24/2006 Advisory Action). Support for the inclusion of the skin, head, neck, prostate, testicle and pancreas of the subject can be found on pages 13-14, Figure 4 and Figure 5 of the specification. The inclusion of skin, testicle and pancreas to claim 1 adds no new matter as DESC1 expression has clearly been demonstrated on pages 13-14 of the specification, Figure 4 and Figure 5. The Applicant points out that a reduced level of DESC1 expression in a tissue normally expressing DESC1, is indicative of cancer in that tissue. Therefore, any and all tissues expressing DESC1 can be diagnosed for cancer by comparing the expression level of DESC1 in tissue suspected of being cancerous to normal tissue. Accordingly, Applicant submits that the rejection of the claims under 35 U.S.C. § 112, first paragraph is rendered moot.

Interview Summary

Applicant's representatives Diane Dobrea and Milan Jovanovic sincerely thank Examiner Sean E. Aeder for the telephone interview on June 13, 2006. The outstanding rejections were discussed, as were proposed amendments. As presented herein, Applicant specifically discussed with the Examiner amendment of claim 1 to include the limitations of claim 23, as suggested by the Examiner, and further recitation in that claim of the tissues skin, testicle and pancreas. The Examiner has agreed to consider Applicant's proposed amendments for allowance, and should

the Examiner dispute the patentability of the pending claims, the Examiner has agreed to consider an Examiner's Amendment. More specifically, should the Examiner determine that claim 1, as amended hereby, is not allowable in view of its recitation of "skin, head, neck, prostate, testicle and pancreas", the Examiner has agreed to consider further amendment to independent claim 1 to include only the limitations of dependent claim 23, thus excluding recitation of skin, testicle and pancreas, and to cancel claims 23 and 29-31, and amend claims 24 and 25 to depend from claim 1.

Conclusion

Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing, Applicant respectfully submits that the claims are now in condition for allowance. Notice to that effect is respectfully requested. If there is any extension of time or fee due in connection with the filing of this Response, Applicant hereby requests such extension and authorizes the Office to charge any such fee to our Deposit Account No. 03-0172.

Respectfully submitted,

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